Rejections Under 35 U.S.C. §103

Claims 31-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yang (RFC 1789) in view of Kenner. (U.S. Patent No. 6,003,030) and Gawlick (U.S. Patent No. 6,175,870). Applicant respectfully traverses.

The invention as defined by independent claim 31 calls for method for selecting a gateway proximal to a network access point that satisfies a predefined call service on a hybrid network, wherein the hybrid network includes a circuit switched network, a packet switched network and a directory service to route a call, including transmitting a query ***including a type of call service*** to a directory service to obtain a plurality of gateways between the packet switched network and circuit switched network that match the ***predefined call service criteria***, sending a message to each of a plurality of gateways to obtain a trace route, ranking the plurality of gateways based on the trace route of each of said plurality of gateways, translating an identifier of a destination of the call from a listing of telephone numbers and associated internet protocol addresses in the directory service, selecting a gateway with a highest ranking from said plurality of gateways, and attempting to route the call over the selected gateway.

For example, claim 31 recites, *inter alia*, "transmitting a query including a type of call service to the directory service to obtain a plurality of gateways between the packet switched network and a circuit switched network that ***match the predefined call service criteria***." The Office Action states that Yang discloses, "[w]hen the first server which generates a query message to a directory server to obtain at least on[e] of a plurality of gateways." Applicant notes that the Office Action has, at a minimum, not provided a teaching or suggestion of the above limitation.

The Office has also failed to provide a teaching or suggestion in Yang of "***transmitting a query . . . to the directory service to obtain a plurality of gateways***" as recited in claim 31. The Office action points to paragraph 2 of Yang as teaching this feature. Applicant respectfully disagrees. There is no teaching or suggestion in Yang concerning transmitting a query . . . to the

directory service to obtain **a plurality** of gateways." At most, Yang merely makes a passing reference to obtaining a **single** remote server from the local directory. (Yang, paragraph 3).

Absent such a teaching, a prima facie case of obviousness has not been made and the rejection of claims 31-38 must be withdrawn.

The Office acknowledges that Yang does not disclose transmitting a message to each of a plurality of gateways to obtain a trace route, ranks the plurality of gateways according to the trace route message, selecting a gateway with a highest ranking from the plurality of gateways to obtain a trace route for attempting to route a call over the selected gateway. (Office action at paragraph 2, page 3).

To make up for this deficiency in Yang, the Office cites Kenner as allegedly teaching "a communication system which queries a database to obtain a list of plurality of servers "gateways" and sends a *trace route* message to each of plurality of gateways and prioritizing the plurality of gateways according to the test results and selecting a highest priority 'shortest hop' to transmit a message." (Action mailed 11-27-01 at page 3, paragraph 2 (emphasis supplied)). Applicant respectfully traverses.

Kenner Teaches Away From the Claimed Combination

Kenner expressly disparages and thus *teaches away* from ranking a plurality of gateways according to results of the trace route message. In the background of the invention where Kenner identifies what is lacking in the prior art Kenner states:

> Traditional network analysis techniques such as the "ping" and "traceroute" programs offer a view of network connectivity but *provide little understanding of what performance can be expected from providers and mirror sites across the Internet. Therefore, only "guesses" can be made* as to where delivery or mirror sites should be located or which mirror sites should be used to optimize performance.
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> (Kenner, Col. 4, line 65 to col. 5, line 6 (emphasis supplied))

One of ordinary skill in the art would conclude from Kenner's disparaging remarks that trace route or ping programs were inadequate and unsuitable tools for prioritizing or *ranking the*

plurality of gateways based on the trace route of each of the plurality of gateways. Indeed, according to Kenner, the inadequacy of ping and traceroute is why there is a need for Kenner's system and method in the first place (Col. 5, Lines 5-6). **It is improper to combine references where the references teach away from their combination.** *In re Grasselli*, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983) Since Kenner teaches away from the combination as recited in claim 31, it cannot provide the necessary suggestion or teachings to make up for the deficiencies of Yang. *The Office has failed to rebut this argument.*

No Motivation to Combine References

The Office has also failed to provide proper motivation for combining these references. The Office states that "Yang suggest that a delay of Internet must be taken into consideration." (Office Action at paragraph 2, page 3). The office also states that the motivation would have been to maintain the quality service of audio packets. (Id.) The Office does not provide a citations to Yang in support of these statements, however, the only mention of "delay" in Yang is as follows:

> With the support of necessary hardware interfaces, the function of an INETPhone server includes:
> ...
> Handle exceptional conditions, such as long delay or drop of voice packets.

(Yang page 3, paragraph3.)

Again, Yang's statement concerns a handling *exceptional conditions* that occur with a **single INETPhone server**. The claimed invention contemplates querying a **plurality** of gateways and selecting a gateway with the highest ranking from said plurality of gateways and attempting to route the call over the selected gateway. Nothing in Yang suggests more than one gateway. The Examiner has repeatedly glossed over this inadequacy of Yang which, again, is a mere wish list of desirable features that completely lacks enabling details. Combining prior art references without the requisite suggestion, teaching, or motivation impermissibly takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the

essence of hindsight. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985), 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). As the Federal Circuit recently repeated in *In Re Sang Su Lee*, Docket No. 00-1158 Filed 18 January 2002 at page 7 'The factual inquiry whether to combine references must be thorough and searching.' It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with (*citations omitted*)." Here the Office's combination rejections are impermissibly based on the inventor's own disclosure. Thus, the rejection of claims 31-38 based on Yang in view of Kenner must be withdrawn.

Gawlick, the third reference cited by the Office does nothing to make up for the deficiencies of Kenner and Yang. The Gawlick reference discusses a two step process (1) the use of a cost function based on a parameter related to the number of hops in a subset of virtual circuit connections previously made in a network to determine potential routing paths on which the VC can be routed at a cost below a specified threshold, and (2) checking to determine which potential routing paths comprise links and nodes with sufficient resources to accommodate the request. (Abstract) Gawlick *fails to even mention* "trace route" (or ping), much less the claimed ranking the plurality of gateways *based on the trace route* of each of the plurality of gateways.

No other reference of record makes up for the deficiencies of Yang, Kenner and Gawlick. Since a *prima facie* case of obviousness has not been made, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 31 and 35 under 35 U.S.C. § 103(a).

The dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. Moreover, these claims recite additional subject matter which is not suggested by the cited documents taken either alone or in combination. For at least the above-identified reasons, applicant respectfully requests that the rejections of the claims under 35 U.S.C. § 103(a) be reconsidered and withdrawn and the claims passed to early issue.

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The Office Improperly Attempts to Shift the Burden Regarding Applicant's Contention that Yang is Not Enabling

In the Remarks mailed July 24, 2000, repeated in the amendment mailed January 22, 2001 and remarks mailed August 27, 2001, applicant objected to the Yang reference as failing to provide an enabling disclosure sufficient for rejecting the invention as claimed herein. The Office has not yet properly responded to these arguments. Applicant renews the objection to Yang as failing to provide an enabling disclosure and request that the Office respond in detail to the argument that Yang is not enabling.

"The test whether a particular [aspect] described in the prior art may be relied upon to show obviousness is whether the prior art provided an enabling disclosure with respect to [applicant's] disclosed [aspect]. Because the evidence showed that a certain [aspect] was a 'hypothetical structure,' it was not persuasive of obviousness." *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986).

In the Office Action mailed November 27, 2001, the Examiner stated "applicant must provide which parts of Yang's apparatus is not enable. (sic)" (Office Action of 11-27-01 at 4). Particularly lacking is the operation of the INETPhone directory server. Indeed, Yang himself suggests that his document would not provide an enabling disclosure by stating "the function of a Directory Server for the INETPhone may require another open specification." (Yang at page 4, paragraph 4). Respectfully, the Examiner is again reminded the Yang reference is not a patent. *There is no presumption that this nonpatent document provides an enabling disclosure* as would be the case with a U.S. Patent. Thus, the Office **bears the burden** of showing that the reference provides an enabling disclosure as to the elements of the claimed invention. Respectfully, this burden has not been met.

In the Office Action mailed November 27, 2001, the Examiner concludes, without providing any specific citations or support from the Yang reference : "[a]fter reading the Yang's publication, one of ordinary skill in the would have been known (sic) how to establish an internet

telephony by obtaining the gateway and directory servers which has a database for matching a telephone number with a plurality of IP address which are nearest to the telephone number is submitted by user. . ." (Office Action of 11-27-01 at 4). This conclusion is not supported by Yang, not enabled by Yang and is merely the Examiner's hindsight conclusion based on the teachings of applicant's disclosure.

Yang emphasizes the informal nature of his writing, stating that the memo "does not specify an Internet standard of any kind" (page 1, "Status of this Memo"). Rather than setting forth details sufficient to provide a basis for one of ordinary skill in the art to make and use the claimed invention without undue experimentation, Yang's memo is more of an opinion piece on what the internet will be. For example, he expresses his view that "[s]uch a phone service through the Internet **will be a major step**" (page 1, Abstract, emphasis added). Additionally, in Yang's "Recommendation," he states, **"[I]f there is enough interest** . . . IAB [Internet Architecture Board] may need to consider forming a special task force . . . to **further look into the matter**." (page 5, "Recommendation," emphasis added). Furthermore, Yang states, "telephone service on the Internet **will be a major step** . . . and a great challenge to the **future** development of the Internet infrastructure and protocol architecture" (page 2, Introduction, last paragraph, emphasis added). Lastly, with respect to the "directory servers" discussed in Yang, Yang acknowledges that "the function of a Directory Server for the INETPhone may require another open specification."

The foregoing is clearly not the language of an enabling disclosure, it is instead a wish list for future developments without providing any enabling detail as to how such developments could be realized. The Yang memo is simply not sufficient to provide the requisite teaching or suggestion to render the present invention obvious. "Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present." MPEP § 2141, rev. July 1998, p. 2100-103, emphasis added.

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Instead of rendering the present invention obvious, the passages in Yang demonstrate that the present invention addresses a solution to the needs and failures plaguing the prior art. This is a far cry from an actual teaching or suggestion, for example, of "a method for selecting a gateway proximal to a network access point that satisfies a predefined call service on a hybrid network" as recited in claim 31. In fact, it shows that Yang recognized the need for such a system in the future, a classic indication of nonobviousness under *Graham v. John Deere Co.*, 86 S. Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966). Thus, the present invention is at least picking up where the prior art teachings end by creating a solution to the problems plaguing the prior art.

Accordingly, a *prima facie* case of obviousness has not been properly established, and it is respectfully urged that the rejection of claims 31-38 be reconsidered and withdrawn.

Many other significant differences between the references of record and the claimed invention will be apparent to one of ordinary skill in the art. In particular, nothing taught or suggested in any other reference of record makes up for the shortcomings of Yang.

New Claims

New claims 39 and 40 have been added to further define certain features of the claimed invention. The amendments to the claims constitute a *bona fide* attempt by applicants to advance prosecution of the application and obtain allowance of certain claims, and are in no way meant to acquiesce to the substance of the rejections.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. If the Examiner has any questions or concerns regarding this application, please contact the undersigned at direct dial (612) 312-2209.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 501373.

Respectfully submitted,

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